

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

X ONE, INC.,
Plaintiff,

v.

UBER TECHNOLOGIES, INC.,
Defendant.

Case No. 16-cv-06050-LHK (SVK)

**TENTATIVE RULING AND
QUESTIONS FOR JUNE 6, 2019
HEARING; PRELIMINARY ORDER
IN RE DISCOVERY DISPUTE
(ECF 153)**

Re: Dkt. Nos. 129, 147, 153, 158

To assist the Parties in their preparation for the June 6, 2019 hearing on Uber's motion to amend its invalidity contentions (ECF 129), this order sets forth the Court's tentative ruling and questions.

Tentative Ruling: The Court **DENIES** Uber's motion to amend its invalidity contentions because Uber has not demonstrated sufficient diligence in seeking leave to amend. First, Uber cited the Benefon system in its original invalidity contentions, which it served in April 2017. Second, the Way-to-Go app is available on any Motorola i730 mobile phone, and X One made its prototype available for inspection in June 2017. Third, the Honorable Lucy H. Koh denied Uber's § 101 motion in March 2017 (ECF 52), and the IPR proceedings concluded in October 2018 (ECF 82). As a result, Uber was aware of its purported basis for the § 101 and § 112 clarifications when the stay was lifted on November 15, 2018. ECF 89.

Questions:

- What are the specific representations or statements that X One made during the IPR proceedings that give rise to the need to add the Benefon and the Way-to-Go app prior art contentions?

- What are the specific “new and narrowing claim interpretations” that X One presented during the IPR proceedings that give rise to need for § 101 and § 112 clarifications?

The Court will be prepared to address the discovery disputes set forth in the Parties’ May 23, 2019 joint discovery letter (ECF 153). Counsel with authority to meet and confer to resolve these disputes shall attend the June 6, 2019 hearing. *See* ECF 165.

SO ORDERED.

Dated: June 4, 2019



SUSAN VAN KEULEN
United States Magistrate Judge